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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,737	04/03/2006	Martin Barkley Harris	DYC-00900	5595

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EXAMINER

PATEL, MUNJALKUMAR C

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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06/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/574,737	Applicant(s) HARRIS ET AL.	
	Examiner Munjal Patel	Art Unit 2617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Rafael Pérez-Gutiérrez/
Supervisory Patent Examiner, Art Unit 2617

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's argument on page 3 p. 3 - page 4 p.1 and page 10 p. 3 - page 14 p. 1 regarding Shmulevich, TS 23.040 & Provost failing to teach "wherein the IP network includes an authentication server which is operable to determine the IP/SMS gateway address from the IP network via which the user equipment is communicating", however, the Examiner respectfully disagrees as Shmulevich in view of TS 23.040 discloses MS communicating/authenticating with SGSN & SMSC-GMSC (TS 23.040 Fig 16a, 18b-d & Fig 5) where VLR resolves IP address of SMSC-GMSC & SGSN in order to communicate with HLR. Hence, the Examiner's interpretation of authentication server which is operable to determine the IP/SMS gateway address from the IP network.

Applicant's argument on page 4 p. 2 - page 5 p. 2 regarding "Fig 16a of TS 23.040" shows GSM environment hence authentication process is not performed on IP network but GSM network, however, the Examiner respectfully disagrees with Applicant's conclusion as Fig 16a, clearly discloses use of SGSN (packet network) as an option of GSM network (refer to Note 1 of Fig 16a: if the SGSN is used, paging and authentication are performed by SGSN) hence it is interpreted as an IP network authentication, any entity that is performing authentication in IP network is considered as part of it.

Applicant's argument on page 5 p.3 regarding "SMS data is not transmitted to individual device (User Equipment or UE) via an IP network, Shmulevich: paragraph 0054 as indication of IP network connection between the gateways but not between mobile network and User Equipment (UE), the Examiner disagrees as paragraph 54 lines [4-7] clearly suggest cellular infrastructure is directly connected to UE, it also suggests cellular infrastructure is replaced by IP network, when both are combined as suggested, IP network directly communicating with UE. However, for citation the Examiner has clearly provided additional reference Provost (Col 3 lines [24-26] & [34-47]) to prove UE communicating directly with IP Network. Further, Applicant also argues regarding possible meaning of "cellular infrastructure", is either "all the network equipment other than User terminal", or "to include UE as a part of cellular infrastructure as well depending on context", the Examiner agrees with Applicant's argument of broader meaning of "cellular infrastructure", however, in either case when the cellular infrastructure is replaced by IP Network infrastructure, Applicant's invention can be achieved.

In response to Applicant's arguments against the references individually on page 7 p. 2 regarding Shmulevich does not inherently teach the IP network of figure 3A connecting directly to UE, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, Applicant also argues on page 8 p. 1 & page 10 p. 3 - page 14 p. 1 regarding Provost failing to teach "direct access of UE to packet switched network", however, the Examiner respectfully disagrees as cited in Office action dated 03/17/2010 Provost (Col 6 lines [1-16] and Col. 3 lines [34-47]) discloses mobile with SIP stack which generates messages for call establishment between mobile and another node over packet switched (internet protocol is packet switched protocol) data network. Hence, the Examiner's interpretation of mobile communicating directly with network node over IP protocol.

Applicant's argument on page 8 p. 2 & page 10 p. 3 - page 14 p. 1 regarding Shmulevich p. 0024 & 0018 fails to disclose the user equipment acting as internet protocol client, however, Shmulevich p. 0018 disclose a media gateway unit adapted to receive from the cellular switching center upstream media data and to packetize the media data for transmission over the packet switched network, i.e., even if the media gateway is part of the LAN, it communicated directly with IP network & cellular switched network. Hence, if UE is part of the LAN it is directly connected to the packet switched network via media gateway, hence mobile being IP client. Besides, for citation the Examiner has clearly provided additional reference Provost (Col 3 lines [24-26] & [34-47]) to prove UE communicating directly with IP Network.

Applicant's argument regarding 35 U.S.C. 103 on page 8 p. 0003 – page 10 p. 0002 & page 10 p. 3 - page 14 p. 1 regarding Provost & Shmulevich are either non-analogous art or teaches away from the Applicant's invention and there is no reason/incentive/motivation to combine both with TS23.040, however, the Examiner disagrees as Applicant's invention is related to telecommunication system for communicating a SMS (short message service) to UE (User Equipment) using subscriber identity number terminating on IP network. Shmulevich discloses a system that transmits and receive signaling messages and media data (i.e. SMS) over packet switched network (i.e., IP network), Provost discloses system for providing prepaid SMS service in packet radio network (GPRS, LAN WAN & IP network) & TS 23.040 provides an Industry standard for SMS service. Hence, all the references are in the similar field on endeavor and provides analogous art.

In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Shmulevich and Provost is as cited in this action along with combining with TS23.040 is to provide compatibility with 3GPP standard.

In response to Applicant's argument that page 8 p. 0003 – page 10 p. 0002 & page 10 p. 3 - page 14 p. 1 regarding Shmulevich teaches away from the claimed invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant's argument on page 14 ¶ 0002 - page 15 ¶ 0002 & page 15 ¶ 0004 - page 17 ¶ 0001 regarding Shmulevich, Provost, TS 23.040 & Uyless fails to teach setting a flag and the fact that a class B station is capable of "monitoring" both circuit switched and packet switched networks do not imply flag is set when the UE is attached to an IP network", however, the Examiner disagrees, it is very well known technique in art to have a flag as an indication of an event, or to monitor a particular condition, here it is UE being attached to IP network. Uyless indicates monitoring the event as cited, it is obvious to perform it via setting a flag to indicate it.

Applicant's argument on page 15 ¶ 0004 - page 15 ¶ 0001 regarding Shmulevich, Provost, TS 23.040 & Uyless fails to teach Similarly response to Applicant's argument regarding dependent claims 2-4, 7-9, 11, 12, and 15-17 can be found above.

In the present response of the instant application, the Applicant's arguments essentially do not traverse the issue(s) as addressed above and/or as rejected in the Final Action. Therefore, in view of the reasons above, the Final Action mailed on March 17th , 2010 is maintained.